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APR 13 2010

In re Application of : **OFFICE OF PETITIONS**
Nishtani et al. :
Application No. 10/587,509 : ON APPLICATION FOR
Filed: July 27, 2006 : PATENT TERM ADJUSTMENT
Attorney Docket No. 05273.0101 :
Title: PROCESS FOR PREPARING :
REBAMIPIDE :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT -PRE-GRANT" filed November 4, 2009. This petition is properly treated under 37 CFR §1.705(b). Applicants submit that the correct patent term adjustment to be indicated on the patent is six hundred eighty (680) days, not three hundred seventy-one (371) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment.

The request for review of the patent term adjustment is
Dismissed.

On August 7, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated the patent term adjustment to date is 371 days. Applicants dispute the calculation.

The Office has considered applicants' argument and finds it unpersuasive that an adjustment is required. Applicants contend a 680 day adjustment is required for failure by the Office to mail at least one of the notifications under 35 U.S.C. 132 not later than fourteen months after the date on which the application fulfilled the requirements under 35 U.S.C. 371, pursuant to 37 CFR §1.702(a)(1). A Notice of Allowance was mailed on August 7, 2009, which is 14 months and 371 days after the application fulfilled the requirements of 35 U.S.C. 371 on June 1, 2007. Petitioner contends fulfillment of the application was met on July 27, 2006.

However, a review of the record shows that the requirements of 35 U.S.C. 371 were fulfilled on June 1, 2007. As early commencement was not requested, the last of 371 requirements to be completed was commencement at 30 months on June 1, 2007. Thus, the mailing of the Notice of Allowance on August 7, 2009, is 14 months and 371 days after fulfillment.

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance is 371 days.

As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the 37 CFR 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Charlema Grant, at (571) 272-3215.

A handwritten signature in black ink, appearing to read 'Anthony Knight', is written over the printed name.

Anthony Knight
Director
Office of Petitions